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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,452	11/20/2003	Ulrich Sander	33997. 0093 (L 012 P-US)	9827
26712	7590	07/18/2006	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			AMARI, ALESSANDRO V	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,452	<b>Applicant(s)</b> SANDER, ULRICH	
	<b>Examiner</b> Alessandro V. Amari	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 5, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura US2001/0010592.

In regard to claim 1, Nakamura discloses (see Figures 1-3) a stereomicroscope comprising an objective (21) having an optical axis extending substantially vertically, a zoom system (22) downstream of the objective, and a deflector element (P1) between the objective and the zoom system for deflecting observation beams emerging from the objective into corresponding magnification or observation channels of the zoom system; wherein the zoom system includes at least three substantially horizontally extending magnification or observation channels (corresponding to 5, 8, 9, 11, 12).

Regarding claim 2, Nakamura discloses (see Figures 1-3) that the zoom system has four magnification or observation channels (corresponding to 5, 8, 9, 11, 12).

Regarding claim 4, Nakamura discloses (see Figures 1-3) that the zoom system has four magnification or observation channels (corresponding to 5, 8, 9, 11, 12) and two of the magnification or observation channels of the zoom system extend horizontally

at the same height (see 8, 9) and two of the magnification channels of the zoom system extend horizontally at a vertical spacing from one another (see 5, 11).

Regarding claim 5, Nakamura further discloses (see Figures 1-3) another deflector element (P2) downstream of the zoom system for deflecting fewer than all of the observation beams.

In regard to claim 8, Nakamura discloses (see Figures 1-3) a stereomicroscope comprising an objective (21) having an optical axis extending substantially vertically, a zoom system (22) downstream of the objective, and a deflector element (P1) between the objective and the zoom system for deflecting observation beams emerging from the objective into corresponding magnification or observation channels of the zoom system; deflector elements (B2, P2) downstream of the zoom system for redirecting observation beams along a horizontal direction that is substantially opposite to a horizontal direction along which the observation beams travel through the zoom system, wherein the zoom system includes at least three substantially horizontally extending magnification or observation channels (corresponding to 5, 8, 9, 11, 12).

Regarding claim 9, Nakamura further discloses (see Figures 1, 2) at least one optical add-on component (8, 9, 12) having a horizontally or vertically extending optical axis.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Kleinberg US 5,052,789.

In regard to claims 6 and 7, Nakamura teaches the invention as set forth above but in regard to claims 6 and 7, does not teach that the stereomicroscope further comprises a deflector element which is pivotable about a horizontal or vertical axis.

Regarding claims 6 and 7, Kleinberg does teach (see Figures 2, 10) a deflector element (36, 38, 48, 50, 60, 62) which is pivotable about a horizontal or vertical axis as described in column 3, lines 49-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to pivot the deflector element as taught by Kleinberg in the stereomicroscope of Nakamura in order to allow for angular deviation of the microscope system while maintaining correct image orientation.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Straehle et al US 20030165012.

Regarding claim 10, Nakamura teaches the invention as set forth above but does not teach an SDI element.

Regarding claim 10, Straehle et al does teach (see Figure 7) an SDI device (750) as described in page 6, paragraph 0063.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the SDI as taught by Straehle et al in the

stereomicroscope of Nakamura in order to provide reversion of the optical image for ease of viewing of the object.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Simon et al US 6,356,088.

Regarding claim 11, Nakamura teaches the invention as set forth above but does not teach a laser shutter.

Regarding claim 11, Simon et al teaches a laser shutter as described in column 2, lines 15-33.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a laser shutter as taught by Simon et al in the stereomicroscope of Nakamura in order to ensure laser safety in the device.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Takahama et al US 5,861,982.

Regarding claim 12, Nakamura teaches the invention as set forth above but does not teach that the add-on component includes an optical splitter.

Regarding claim 12, Takahama et al teaches the at least one opto-mechanical component includes a beam splitter as described in column 10, lines 49-53.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the opto-mechanical components as taught by Takahama et al in the stereomicroscope of Nakamura in order to accurately insert/remove optical components into/from corresponding switching positions without a complicated adjustment as described in column 6, lines 13-18 of Takahama et al.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Shioda et al US 6,081,371.

Regarding claim 13, Nakamura teaches the invention as set forth above but does not teach a data projecting device.

Regarding claim 13, Shioda et al does teach (see Figures 18, 19) a data projector (126, 127, 129, 130, 131, 132).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the data projector of Shioda et al in the stereomicroscope of Nakamura in order to observe other data about the specimen in the same visual field as the observed image of the specimen.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592.

Regarding claim 14, Nakamura teaches the invention as set forth above but does not teach a filter. Official Notice is taken that it is notoriously old and well known in the microscope art to have additional components such as filters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add filters to the stereomicroscope of Nakamura as claimed above in order to provide improved viewing of the specimen under examination.

### ***Response to Arguments***

10. Applicant's arguments filed 15 May 2006 have been fully considered but they are not persuasive.

The Applicant argues that the zoom system 22 of Nakamura includes only two magnification channels for stereoscopic viewing. The Applicant takes issue with the Examiner's position that the zoom system 22 includes five magnification or observation channels corresponding to elements 5, 8, 9, 11 and 12. The Applicant asserts that Nakamura uses beam splitter pairs B2, B3 and B4 after the zoom system 22 to divide and branch the two zoom system channels to various output elements.

In response to this argument, the Examiner would like to point out that (1) the Applicant has not assigned any special definition to the word "channel" in his specification and (2) the applicant's claimed invention (see Figure 1 of the Applicant's application) also uses beam splitters and deflectors (5, 6a-6d, 9) in order to route the various "channels" in the zoom system to multiple observation axes (14, 15, 18) or output elements. The channels in the zoom system of the Applicant's claimed invention are separated into various observation axes (each constituting a separate channel). In the same way, Nakamura has magnification or observation channels in the zoom system which are then separated out into at least four separate observation axes or channels to various output elements (5, 8, 11, 12). Therefore, given the current claim recitation, Nakamura is taken to read on the claim limitation of providing at least four magnification or observation channels.

The Applicant further argues that the stereomicroscope as defined by the claims 1 and 8 exhibits important advantages over the prior art Nakamura.

In response to applicant's argument that the reference fails to show certain features or advantages of applicant's invention, it is noted that the features upon which



applicant relies (i.e., improvement in free working distance; improvement in light intensity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ava:aq  
12 July 2006

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